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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,395	01/03/2002	Barry H. Katz	00616/RSB	7349

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
767 THIRD AVENUE  
25TH FLOOR  
NEW YORK, NY 10017-2023

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/037,395

Applicant(s)

KATZ

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 12 is/are rejected.
- 7) ☒ Claim(s) 2-3 and 5-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

*Election/Restrictions*

1. Claims 10-11 and 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.
2. Applicant's election with traverse of invention I, claims 1-9 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that all the claims are directed to a stabilization device for a sneaker or athletic shoe and that all the inventions were classified in the same class and therefore the search for all inventions would not be burdensome upon the examiner. This is not found persuasive because, although all claims may be directed to a stabilization device, they are deemed to be subcombinations disclosed as useable together and therefore are properly restricted. With respect to the argument that all the inventions were classified in the same class and therefore it would not be a burden upon the examiner to examine all the claims, the inventions were classified in different subclasses of the same class and therefore the search for one invention would not necessarily include the search for the other inventions, thereby being "burdensome" on the examiner to search

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in subclasses that would not be necessary for the elected invention. The requirement is still deemed proper and is therefore made FINAL.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 contains the trademark/trade name Velcro®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe hook and loop fastening means and, accordingly, the identification/description is indefinite.

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*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sanchez 5,819,439 or Cochrane 5,269,078.

Sanchez '439 discloses all the limitations of the claim including the following: a bottom component (the sole) having a top surface (facing the user's foot) and a bottom surface (facing the ground); the bottom component including a sole having an upper surface and a lower surface; an upper component (the vamp 160 extending from the top surface of the bottom component for accommodating a foot therein; the upper component having a medial sidewall, a lateral sidewall, a back portion between the sidewalls (see Figure 2); two elongate straps 24 and 30; one end of each strap attached to the inner surface of the shoe (see Figures 3 and 40; the two elongate straps capable of supporting the ankle mortise and lateral ligaments of a foot within the shoe (crossing in front of the user's foot on top of the arch); the two elongate straps each having a free end which

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is detachably securable to each other and the outer surface of the shoe (see Figures 2-4); the straps being tightenable (by hook and loop means).

Cochrane'078 discloses all the limitations of the claims including the following: a bottom component (sole 12) having a top surface (that facing the user's foot) and a bottom surface (that facing the ground); the bottom component including a sole having an upper surface and a lower surface; an upper component 15 extending from the top surface of the bottom component for accommodating a foot therein (see Figures); the upper component having a medial sidewall, a lateral sidewall, a back portion between the sidewalls (typical upper for an enclosing shoe); two elongate straps (one including strap portion 79 and the other including strap portion 106); one end of each strap attached to the inner surface of the shoe (see Figure 2); the two elongate straps capable of supporting the ankle mortise and lateral ligaments of a foot within the shoe (straps cross in the front portion of the user's foot on top of the arch area as shown in the Figures); the two elongate straps each having a free end which is detachably securable to each other and the outer surface of the shoe (see the Figures); the straps being tightenable (by the hook and loop material shown.

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*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of the references as applied to claim 1 above in view of Seydel et al. 6,266,897. The references as applied to claim 1 above disclose all the limitations of the claim including the sidewalls of the upper being sufficiently stiff to support the user's foot during stress due to small angles of roll. The references do not disclose the at least two support bumps on an outer surface of the lateral sidewall, the bumps adjacent the shoe sole and above the bottom surface, the bumpers being located in the heel and ball area. Seydel et al. '943 teaches that footwear can contain bumpers 190, 196) located on the lateral side of the shoe to aid in preventing the side impacts and to aid in preventing roll-over of the user's foot during use, thus preventing twisted ankles(col. 21, lines 19-25). Therefore, it would have been

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obvious, to one of ordinary skill in the art at the time the invention was made, to place bumpers, such as those shown in Seydel et al. '943, on the outer or lateral side of the shoe of either one of the references as applied to claim 1 above to prevent roll-over of the user's foot especially when making cutting moves or when most of the user's weight is moved to the side of the shoe.

#### *Allowable Subject Matter*

9. Claims 2-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

10. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.



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Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125

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Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
August 25, 2003